

Remarks

This Amendment has been made in response to the Office Action of June 22, 2004. Applicants have reviewed the Office Action in detail and appreciate the Examiner's attention to this application.

Claims 1-7 were pending in this application. Applicants submit new claims 8-14 herein.

Claims 1-7 were rejected under 35 USC 103(a) as being unpatentable over Szumer (U.S. Patent No. 6,418,634). As conceded by the Examiner, Szumer fails to disclose the hang liners as claimed. Notwithstanding this deficiency, the Examiner, citing *St. Regis Paper Co. v. Bemis Co. Inc.*, 549F.2d 833, 193 USPQ 8 (7th Cir. 1977) for the proposition that the mere duplication of the working parts of a device involve only routine skill in the art, concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a duplication of Szumer's hand holds "through any additional orifice for the purposes of providing additional, raised surface areas on the non-setting face."

Rejections based on 35 USC 103(a) must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173,177-78 (CCPA 1967). In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

In the present case, the Examiner fails to advance any factual basis to supply the admitted deficiencies of Szumer vis-a-vis the subject matter recited in independent claim 1. Instead, the examiner attempts to bridge Szumer's evidentiary gaps by resort to so-called mechanical or *per se* rules of obviousness allegedly established by the *St. Regis* case. Such rules do not exist, however, and the reliance thereon by the examiner to establish obviousness under 35 USC 103(a) is improper. See *In re Ochiai*, 71 F.3d 1565, 1570, 37USPQ2d 1127, 1132 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

New claims 8-14 further require that the hand-holds and hang liners include "an interior surface defining a first outer flange, a first inner flange, a second outer flange, and a second inner flange, the first outer and inner flanges forming a first channel for receiving the

first wall, the second outer and inner flanges forming a second channel for receiving the second wall.” As is clearly shown in its Figure 2, Szumer fails to provide any inner flanges or channels for receiving the walls of the box level. Szumer includes only a outer rim portion. Therefore, Applicant believes that claims 8-14 are allowable over the prior art.

Indeed, Applicant believes that all claims are in proper form for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned attorney if that would be helpful in facilitating resolution of any issues which might remain.

If any fees are due, please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,

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